No. 83-1247

IN THE

Supreme Court of the United States

OCTOBER TERM, 1983

Powell Manufacturing Company, Inc.
Petitioner,

v.

Harrington Manufacturing Company, Inc.
Respondent

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES
COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

I

OPINIONS BELOW

The recommendations of the Magistrate, and the opinions of the District Court and the Court of Appeals for the Federal Circuit are unreported and have been reproduced in the Appendix to the Petition for writ of certiorari filed by Powell Manufacturing Company, Inc.

II

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

III

STATEMENT OF THE CASE

The facts of the case are stated fully in the Magistrate's recommendations (Petitioner Appendix at 1-43) and in the

decisions of the District Court (Petitioner Appendix at 44-50) and the Federal Circuit (Petitioner Appendix at 55-61).

IV

REASONS FOR DENYING THE WRIT

The instant Petition for a writ of certiorari should be denied because first, no issue has been raised which warrants review by this Court and, second, the Court of Appeals for the Federal Circuit correctly determined that it has no jurisdiction to hear an appeal from the District Court's interlocutory Order denying Petitioner's pre-trial Motions for summary judgment and judgment on the pleadings.

A. The Instant Petition Does Not Raise Issues Which Warrant Review By This Court

By couching the question presented as purely a legal issue of jurisdiction, Petitioner attempts to lend great import to the Federal Circuit's decision below. However, the present situation is not one in which the lower court "has so far departed from the accepted and usual course of judicial proceedings ... as to call for an exercise of this Court's power of supervision." Sup.Ct.R. 17.1(a).

Although review on writ of certiorari is a matter of judicial discretion, this Court has stated clearly that a petition "will be granted only when there are special and important reasons therefore." Sup.Ct.R. 17. And, as explained in Rice v. Sioux City Memorial Park Cemetery, Inc.

349 U.S. 70, 74 (1955), "'[s]pecial and important reasons' imply a reach to a problem beyond the academic or episodic." However, in granting Respondent's Motion to dismiss the appeal, the Federal Circuit correctly applied well-settled law regarding appellate jurisdiction to the unique facts of the case at bar. The Federal Circuit did not render a decision in conflict with other circuits. Nor did the Federal Circuit render a decision on a grave constitutional issue. In fact, the decision below was "episodic" in the truest sense of the word; it was of limited significance to the particular parties in a particular lawsuit.

Inasmuch as there are no "special and important reasons" for granting review of the question presented by Petitioner, the

instant Petition for a writ of certiorari should be denied.

B. The District Court's Order Below Is Not A "Final Decision" Pursuant To 28 U.S.C. §1295(a)(1).

Under 28 U.S.C. §1295(a)(1), the Court of Appeals for the Federal Circuit has exclusive jurisdiction of appeals from a "final decision" of a district court in patent suits. This Court has "consistently interpreted this language as indicating that a party may not take an appeal under this section until there has been 'a decision by the District Court that ends the litigation on the merits and leaves nothing for the court to do but execute the judgment.'" Firestone Tire & Rubber Co. v. Risjord, 449 U.S. 368, 373 (1981), quoting from Coopers & Lybrand v. Livesay, 437 U.S. 463, 467 (1978).

Clearly, an order which merely denies pre-trial motions for summary judgment and judgment on the pleadings is not such a "final decision". Switzerland Cheese Ass'n, Inc. v. Hornes Market, Inc., 385 U.S. 23, 25 (1966).

Nor is the District Court's Order one of the "small class" of decisions which this Court considers appealable under 28 U.S.C. §1295(a)(1) because they ". . . finally determine claims of right separable from, and collateral to, rights asserted in the action, too important to be denied review and too independent of the cause itself to require that appellate consideration be deferred until the whole case is adjudicated." Cohen v. Beneficial Indus. Loan Corp., 337 U.S. 541, 546 (1949). Petitioner's persistent asser-

tions to the contrary are simply without merit.

Although frequently characterized as an exception to the "final decision" requirement of 28 U.S.C. §1295(a)(1), the Cohen "collateral order doctrine" actually does nothing more than clarify the definition of a "final decision" for purposes of appeal. By recognizing some decisions rendered by a District Court as final regarding the merits of a particular claim in controversy, albeit not final in the sense that litigation on the merits has ended, this Court merely insured that a party need not await the outcome of related pending litigation before seeking an appeal of that separable decision. However, no amount of rhetoric can possibly convert the District Court's Order

in the instant suit into such an appealable "final decision".

Petitioner's motions for summary judgment and judgment on the pleadings raised several affirmative defenses to Respondent's claims of patent infringement, and the defenses failed as a matter of law at the pre-trial stage. Nevertheless, Petitioner's decision to test its affirmative defenses by pre-trial motions did not transform the defenses into "claims of right separable from, and collateral to, rights asserted in the action." Cohen, Id. To the contrary, Petitioner's affirmative defenses are inextricably linked to the merits of the controversy below. Although insufficient to support a motion for summary judgment or judgment on the pleadings, Petitioner's defense of bar by prior consent judgment

may be raised during the trial itself where, as noted by the Federal Circuit, Petitioner "can still press the issue by introducing extrinsic evidence...to prove its assertions regarding the real intent of the parties." (Pet. App. at 57-58). As to the defense of bar by Rule 13(a) of the Federal Rules of Civil Procedure, the Federal Circuit aptly noted that the order cannot be considered appealable "because the decision involved can be reviewed and corrected if and when final judgment results." (Pet. App. at 58).

In view of the foregoing, the instant Petition for writ of certiorari should be denied so that the parties, at long last, can proceed to a "final decision" on the merits of the controversy below.

C. The District Court's Order Below Is Not An Order Denying An Injunction Pursuant To 28 U.S.C. §1292(c)(1).

Petitioner's efforts characterize the District Court's Order as one which denied an injunction are, at best, unpersuasive and, at worst, ridiculous. Although purporting to seek injunctive relief by requesting that Respondent be forever enjoined from prosecuting its patent infringement claims against Petitioner, it is abundantly clear from the nature of the defenses raised by Petitioner that, had its motions in the lower court been granted, there would have been no need for an injunction. Petitioner's defenses were legal defenses and a ruling in its favor would have barred Respondent from further prosecuting its patent infringement claims as a matter of law. Any request for an

injunction made by Petitioner was merely superfluous and had no legal effect.

Consequently, because "it is a misnomer to call a request that a court exercise a control over the very case before it a request for injunctive relief", the Federal Circuit rejected Petitioner's attempt to "bring the case under a statute dealing with requests for injunctive relief properly so called." (Pet. App. at 60).

In so doing, the Federal Circuit was in keeping with this Court's mandate "to see that no unauthorized extension or reduction of jurisdiction, direct or indirect, occurs in the federal system", Baltimore Contractors v. Bodinger 348 U.S. 176, 181 (1955). Accordingly, the instant Petition for a writ of certiorari should be denied.

CONCLUSION

For the foregoing reasons, the Petition for writ of ceriorari filed by Powell Manufacturing Co., Inc. should be denied.

Respectfully submitted,

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